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EXAMINER

GLESSNER, BRIAN E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,320

Applicant(s)

DOWNEY, PAUL CHARLES

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed on January 16, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The applicant did not submit a copy of any of the references listed on the IDS. However, since the US references were readily available, they were considered. The brochure's listed on the IDS were not considered because a copy was not received. Also, US reference no. 5,653,009 was not considered because it does not seem to be related to the applicant's claimed invention. Further, US patent no. 5,653,009 was not issued to MacKenzie.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference numbers 2 and 5 are not in the figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: Page 4, lines 16 and 17, the top layer 8 should be the top layer 7 to correspond to the drawings; Page 5, line 20, position should be positioned; Page 6, lines 4, 7, and 10, adhesive 5 should be adhesive 20 to correspond to the drawings, and Page 7, line 23, will by should be will be.

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Appropriate correction is required.

***Claim Objections***

4. Claim 21 is objected to because of the following informalities: Claim 21 is not in one sentence form. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 6, 8, 10, 11, 13, 14, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mashunkashey et al. (5,714,219).

In regard to claim 1, Mashunkashey discloses a flooring system comprising a sub-floor 43, a “decorative” top layer 41 or 51, and a substrate 21 having a top surface and an oppositely facing bottom surface, the bottom surface positioned proximate the sub-floor and the top surface is positioned proximate the decorative top layer, the substrate having voids, column 4, lines 65 and 66, i.e. porous (voids) to water, which extend between the top surface and the bottom surface, the substrate is manufactured from rubber 23 in sheets that are capable of being cut to the desired configuration, whereby it is inherent that the substrate has the strength characteristics to support the decorative layer and prevent damage thereto and the sound dampening characteristics to provide decibel reduction through the substrate, column 5, lines 5 and 6. The examiner would like to point out that since Mashunkashey discloses all of the structural features

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disclosed in applicant's claim, Mashunkashey's structure will inherently be capable of performing the same functions disclosed by applicant.

In regard to claims 8 and 13, Mashunkashey discloses a substrate 21 for use in a flooring system which has a sub-floor 43 and a decorative upper layer 41 or 51, the substrate comprising a continuous sheet 21 having a bottom surface, a top surface, side surfaces, and end surfaces, the top surface and the oppositely facing bottom surface are essentially parallel to each other and are spaced apart by the thickness of the substrate, voids (column 4, lines 65 and 66, i.e. porous (voids) to water) are provided in the substrate, the voids are provided between particles 23 of rubber, whereby when the substrate is positioned between the sub-floor and the decorative top layer, the particles of rubber provide the strength required to prevent deformation of the substrate in the direction of the thickness and the voids are inherently capable of contributing to the sound dampening characteristics that will provide decibel reduction across the thickness of the substrate. Mashunkashey discloses that the member 21 could be used to absorb sound, column 5, line 6.

In regard to claims 3, 10, and 16, Mashunkashey inherently discloses that the substrate has the strength characteristics required to support the decorative layer while also having sufficient resiliency so as to be capable of being delivered in rolls. Mashunkashey discloses at column 4, line 66 that said substrate 21 is resilient.

In regard to claims 6, 11, and 19, Mashunkashey discloses the claimed invention, wherein the substrate is made from an SBR rubber material, column 2, lines 26-28.

In regard to claim 14, Mashunkashey discloses the claimed invention, wherein the continuous sheet is cut to the appropriate length to fit the space requirements.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 12, 20, and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mashunkashey et al. (5,714,219).

In regard to claims 7, 12, 20, and 24, Mashunkashey discloses the claimed invention except for specifically disclosing that the sound dampening characteristics exhibit a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm. However, in the 103 sense, since Mashunkashey discloses all of the structural limitations disclosed by applicant, and since Mashunkashey's substrate is comprised of the same materials, it will inherently be capable of providing the same decibel reduction as applicant's substrate.

In the alternative 103 sense, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make Mashunkashey's substrate have a decibel reduction of 20 dB for a substrate of 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The examiner takes the position that since the applicant's structure and Mashunkashey's structures are the same, they will obviously be capable of performing the same functions.

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9. Claims 2, 9, 15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mashunkashey et al. (5,714,219).

In regard to claims 2, 9, and 15, Mashunkashey discloses the claimed invention, except for specifically disclosing that the density of the substrate is less than 1000 kilograms per meter cubed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Mashunkashey's substrate with a density of less than 1000 kilograms since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Since Mashunkashey's substrate and applicant's substrate are made of the same materials and they are being used for the same function, i.e. to support a floor layer, the examiner takes the position that it would be obvious to make both substrates of the same density.

In regard to claims 21-23, Mashunkashey discloses a substrate for use in a flooring system. Mashunkashey obviously discloses all of the claimed limitations disclosed in claims 21-23. Claims 21-23 are rejected on the same grounds of rejection set forth above with respect to claims 1, 2, 3, and 6.

10. Claims 4, 5, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mashunkashey et al. (5,714,219) in view of Ducharme (6,213,252).

In regard to claims 4, 5, 17, and 18, Mashunkashey discloses the claimed invention except for specifically disclosing that the substrate is fixed to the sub-floor and the top layer by means of an adhesive. Ducharme teaches that it is known to fix a sound absorbing rubber substrate to a sub-floor and a top layer, column 2, lines 61 and 62, and column 4, lines 19-22. Ducharme teaches that using an adhesive to fix the substrate to the sub-floor is well known in the

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art. Ducharme does not specifically disclose that the substrate is secured to the top layer with an adhesive. However, it would have been obvious to one having ordinary skill in the art to use an adhesive for fixing both the top layer and the sub-floor to the substrate because, as taught by Ducharme, using adhesives in floor systems is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adhesively attach Mashunkashey's substrate to his top layer and his sub-floor, because once they are adhesively attached, they will not become separated from the substrate.

***Claim Rejections - 35 USC § 103***

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ducharme (6,213,252) in view of Mashunkashey et al. (5,714,219).

In regard to claim 1, Ducharme discloses a flooring system comprising a sub-floor 22, a "decorative" top layer 20, and a sound absorbing substrate 10 comprising a sheet having a top surface and an oppositely facing bottom surface, the bottom surface is positioned proximate the sub-floor and the top surface is positioned proximate the decorative top layer, the substrate is further comprised of particles of rubber, column 3, lines 29-31, that form a sheet which is cut to fit a desired configuration. Ducharme does not specifically disclose that his substrate has voids located between the particles of rubber that extend between the top and bottom surfaces.

Mashunkashey teaches that it is known to provide a substrate having voids, column 4, lines 65 and 66, i.e. porous (voids) to water. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Mashunkashey's sound absorbing rubber particle sheet for Ducharme's sound absorbing rubber particle sheet, because both sheets will absorb the sound that is produced from walking on the floor. Further, since Mashunkashey's



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substrate has voids, it will also allow moisture to travel through the substrate and out of the floor system.

In regard to claim 2, Ducharme in view of Mashunkashey disclose the basic claimed invention, except for specifically disclosing that the density of the substrate is less than 1000 kilograms per meter cubed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Ducharme in view of Mashunkashey's substrate with a density of less than 1000 kilograms since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Since Ducharme in view of Mashunkashey's substrate and applicant's substrate are made of the same materials and they are being used for the same function, i.e. to support a floor layer, the examiner takes the position that it would be obvious to make both substrates of the same density.

In regard to claim 3, Ducharme in view of Mashunkashey disclose that the substrate has the strength characteristics required to support the decorative layer while also having sufficient resiliency so as to be capable of being delivered in rolls. Mashunkashey discloses at column 4, line 66 that said substrate 21 is resilient. Further, it can obviously be seen in the figures that the substrate is supporting the decorative layer, figure 2 Ducharme.

In regard to claims 4 and 5, Ducharme in view of Mashunkashey disclose the basic claimed invention, wherein the substrate is adhesively fixed to the sub-floor, and the top layer is secured to the substrate, column 2, lines 61 and 62, and column 4, lines 19-22. Ducharme states that using an adhesive to fix the substrate to the sub-floor is well known in the art. Ducharme does not specifically disclose that the substrate is secured to the top layer with an adhesive.

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However, it would have been obvious to one having ordinary skill in the art to use an adhesive for fixing both the top layer and the sub-floor to the substrate because, as taught by Ducharme, using adhesives to secure various layers of a floor system is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adhesively secure the top layer to the substrate.

In regard to claim 6, Ducharme in view of Mashunkashey disclose the basic claimed invention, wherein the substrate is made from an SBR rubber material, column 2, lines 26-28 of Mashunkashey. Further, the examiner would like to point out that both substrates are made of recycled tire rubber and Mashunkashey discloses that tires are often made of SBR rubber, column 2, lines 26-28.

In regard to claim 7, Ducharme in view of Mashunkashey disclose the basic claimed invention except for specifically disclosing that the sound dampening characteristics exhibit a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Ducharme in view of Mashunkashey's substrate have a decibel reduction of 20 dB for a substrate of 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The examiner takes the position that since the applicant's structure and Ducharme in view of Mashunkashey's structures are the same, they will obviously be capable of performing the same functions.

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*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pourtau et al., Kurtze et al., Fleck et al., Holtrop, Eberhart et al., Kakimoto et al., Carter, Crivelli, Cubberley, Peik, and Mazer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.  
December 3, 2002



**BRIAN E. GLESSNER**  
**PATENT EXAMINER**